

**REMARKS**

Pending claims 1-20 have been rejected in the Office Action mailed June 22, 2004. Applicants have amended claims 15-18 to correct typographic errors and to clarify the claim language. Claims 1 and 8 have been amended to include additional language.

**Objections to the Claims and Specification**

Claim 16 was objected to because of an informality. Claim 16 has been amended to delete the word “slip” with “step,” correcting a typographic error. The specification was also objected to as not providing sufficient antecedent basis for the limitation “said image recording slip.” As amended, claim 16 now has sufficient antecedent basis in the specification. Applicants respectfully request that the Examiner withdraw the objections to claim 16 and the specification.

**Rejections under 35 U.S.C. § 102(b)**

Claims 1, 5, 7-10, 12-17, 19, and 20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Cooper et al.* (U.S. Patent No. 4,742,388, hereinafter *Cooper*). Applicants respectfully traverse the Examiner’s rejection of these claims. A claim is anticipated only if each and every element as set forth in the claim is taught by the reference cited. *See* M.P.E.P. §2131. Applicants assert that each claim rejected as being anticipated by *Cooper* contains limitations not taught by the cited reference. Accordingly, a rejection of these claims under 35 U.S.C. § 102(b) is not proper.

**Claim 1**

Claim 1 has been amended to include the limitation of an image sensor sensing multi-color pixel data corresponding to said optical image. No new matter has been included. *Cooper* describes a color video endoscope with image sensor. The image sensor of *Cooper* produces “a signal having sequential portions corresponding to the color fields of light”. Col. 3, lines 43-44. Because the *Cooper* invention utilizes a light source and a color wheel (Col. 3, lines 27-28), the image produced by the image sensor must be limited to sequential monochrome portions corresponding to the light passed by each filter of the filter wheel. *Cooper* does not disclose an image sensor sensing multi-color pixel data corresponding to said optical image as recited in the amended claim 1. Accordingly, *Cooper* does not

anticipate claim 1. Applicants respectfully request that the Examiner withdraw the rejection of record and pass claim 1 to allowance.

### **Claim 8**

Claim 8 has been amended to include the element of a graphic user interface menu. No new matter has been included. Claim 8 is now directed to an apparatus for recording digital images comprising a graphic user interface menu displaying a selection of a filter effect available on a digital visual recording device. *Cooper* does not disclose the element of a graphic user interface menu displaying a selection of a filter effect available on a digital visual recording device. *Cooper* discloses only “color filtering being selected by switches of the filter selector 16 on control unit 12.” Col. 3, lines 46-47. Because *Cooper* does not disclose all of the limitations of claim 8 as amended, the rejection of record is not proper under 35 U.S.C. § 102(b). Applicants respectfully request that the Examiner withdraw the rejection and pass claim 8 to allowance.

### **Claim 15**

Claim 15 is directed to a method for combining filter effects into digital photography comprising the step of recording an image on an electronic media of said digital visual recording device which includes said combined filtering effects. *Cooper* does not disclose this limitation of claim 15. *Cooper* describes three memory storage devices, each of which is preferably a dynamic random access memory (DRAM), for storing digital data corresponding to the output signal for one particular color field from image sensor 72. Col. 4, line 66 to col. 5, line 3. This step is not described as occurring after the filtering operation of *Cooper*. Because *Cooper* does not disclose the limitation of recording an image on an electronic media of said digital visual recording device which includes said combined filtering effects, *Cooper* does not anticipate claim 15. Applicants respectfully request that the Examiner withdraw the rejection of claim 15 under 35 U.S.C. § 102(a) and pass claim 15 to allowance.

### **Claims 5, 7-10, 12-17, 19, and 20**

Claims 5, 7-10, 12-17, 19, and 20 depend directly from claims 1, 5, and 15 and therefore contain all of the limitations of the base claims. For the reasons listed above, claims

1, 5, and 15 are not anticipated by *Cooper*. Therefore, claims 5, 7-10, 12-17, 19, and 20 contain elements not disclosed by *Cooper*, and are allowable over the cited reference.

Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 102(b) rejection of claims 5, 7-10, 12-17, 19, and 20 and pass these claims to allowance.

### **Rejections under 35 U.S.C. § 103(a)**

Claims 2-4, 6, 11, and 18 have been rejected under 35 U.S.C. § 103(a) as unpatentable. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the first or second criteria, Applicants assert that the 35 U.S.C. § 103(a) rejections of record do not satisfy the third criteria. Applicants respectfully traverse the Examiner's rejection of these claims.

### **Claim 2**

Claim 2 has been rejected under 35 U.S.C. § 103(a) as unpatentable over *Cooper* in view of *Adair* (U.S. Patent No. 5,812,188). *Cooper* does not teach all of the limitations of claim 1, as discussed above. Claim 2 depends from claim 1 and therefore contains all of the limitations of the base claim. *Adair* does not cure the deficiency of *Cooper* as support for a 35 U.S.C. § 103(a) rejection. Accordingly, the cited references do not teach or suggest all of the claim limitations of claim 2. Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record and pass claim 2 to allowance.

### **Claims 3 & 4**

Claims 3 and 4 have been rejected under 35 U.S.C. § 103(a) as unpatentable over *Cooper* in view of *Shiomi* (U.S. Patent No. 6,650,361). *Cooper* does not teach all of the limitations of claim 1, as discussed above. Claims 3 and 4 depend from claim 1 and therefore contain all of the limitations of the base claim. *Shiomi* does not cure the deficiency of *Cooper* as support for a 35 U.S.C. § 103(a) rejection. Accordingly, the cited references do not teach or suggest all of the claim limitations of claims 3 and 4. Applicants respectfully

request that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record and pass claims 3 and 4 to allowance.

### **Claim 6**

Claim 6 has been rejected under 35 U.S.C. § 103(a) as unpatentable over *Cooper* in view of *Safai et al.* (U.S. Patent No. 6,167,469). *Cooper* does not teach all of the limitations of claim 1, as discussed above. Claim 6 depends from claim 1 and therefore contains all of the limitations of the base claim. *Safai et al.* does not cure the deficiency of *Cooper* as support for a 35 U.S.C. § 103(a) rejection. Accordingly, the cited references do not teach or suggest all of the claim limitations of claim 6. Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record and pass claim 6 to allowance.

### **Claims 11 & 18**

Claims 11 and 18 have been rejected under 35 U.S.C. § 103(a) as unpatentable over *Cooper*. *Cooper* does not teach all of the limitations of claims 1 and 15, as discussed above. Claim 11 depends from claim 1 and claim 18 depends from claim 15, and each dependent claim contains all of the limitations of the base claims. Because *Cooper* does not teach all of the limitations of claims 1 and 15, a 35 U.S.C. 103(a) rejection of claims 11 and 18 is not proper. Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record and pass claims 11 and 18 to allowance.

In view of the above amendment and remarks, Applicants believe the pending application is in condition for allowance.

Application No.: 09/776,058

Docket No.: 10002214-1

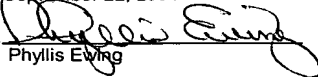
Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10002214-1 from which the undersigned is authorized to draw.

Dated: September 22, 2004

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482734355US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: September 22, 2004

Signature:

  
Phyllis Ewing

Respectfully submitted,

By 

Michael A. Papalas

Registration No.: 40,381

Attorney for Applicant

(214) 855-8186